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08/895,493	07/16/97	SAITO	M 58800.919C

GARY A HECKER  
HECKER & HARRIMAN  
2029 CENTURY PARK EAST  
SUITE 1600  
LOS ANGELES CA 90067

LM02/0316

EXAMINER

SAYADIAN, H

ART UNIT

PAPER NUMBER

2766

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/895,493**

Applicant(s)  
**MAKOTO SAITO**

Examiner  
**Hrayr A. Sayadian**

Group Art Unit  
**2766**



☒ Responsive to communication(s) filed on Aug 24, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 95-142 is/are pending in the application.

Of the above, claim(s) 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122 are withdrawn from consideration.

☐ Claim(s) 124, 128, 130, 132, 134, 138, and 140 is/are allowed.

☒ Claim(s) 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123 is/are rejected.

☐ Claim(s) 125-127, 129, 131, 133, 135-137, 139, 141, 142 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## GENERAL

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The office action mailed on 9-22-1997 is withdrawn to take into consideration the preliminary amendment submitted on 9-16-1997 by Applicant, which preliminary amendment was not available to Examiner at action issue time.

## ELECTION/RESTRICTION

### *Information Regarding the Election Requirement*

3. Applicant's election without traverse of Species I, specifically covering Claims 97, 101, 107, 113, 117, 123, 129, 133, and 139, is acknowledged. Claims 95, 99, 103-105, 109-111, 115, 119-121, 125-127, 131, 135-137, 141, and 142 are generic.
4. Claims 96, 98, 100, 102, 106, 108, 112, 114, 116, 118, 122, 124, 128, 130, 132, 134, 138, and 140 are withdrawn from further consideration by the Examiner, 37 C.F.R. 1.142(b), as being drawn to non-elected species. Election was made **without** traverse in Applicant's Response to Examiner's office action requiring election between species, which response was received at the USPTO on 8-24-1998.
5. *The election of species requirement is still deemed proper and is therefore made FINAL.*

## OBJECTIONS/REJECTIONS NOT BASED ON PRIOR ART

### *DISCLOSURE: Specification*

6. A substitute specification in proper idiomatic English and in compliance with 37 C.F.R. 1.52(a) and (b) is required. A substitute specification is required because the detailed specification contains numerous corrections, making the detailed description ambiguous and generally unclear, thus making it difficult to examine and difficult to print when the application is allowed.

No new matter may not be introduced.

The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

## **REJECTIONS BASED ON PRIOR ART**

7. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by any of Dolphin, Fahn et al. [hereinafter Fahn], Okano, Matsumoto et al. [hereinafter Matsumoto], or Gasser et al. [hereinafter Gasser].

Examiner notes that the independent claims recite, the optional steps of displaying, editing, storing, copying, and transferring. Claims 105, 121, and 137 further recite steps that are optional. The various recitation of keys are read to include the scope of the keys being the same. Consequently, all that the prior art has to have is one permit key and the decrypting of data. The cited prior art, each, teaches a crypt key as well as at least one permit key and the corresponding steps that is the same or equivalent to the recited required limitations of the claims. Examiner notes that the cited prior art deals with data protected by encryption, which expressly and inherently requires a crypt key.

With respect to claims 97, 101, 107, 113, 117, 123, 129, 133, and 139, the entity providing the data, in the cited prior art, is the database and inherently provides the data protecting program. Having copyright information is inherent as the provided data is protected from unauthorized use.

Regarding claims 99, 103, 109, 115, 119, 125, 131, 135, and 141, Examiner notes that copyright information data inherently accompanies data. With respect to claims 104, 110, 120, 126, 136, and 142, Examiner has read "as a computer virus" as intended use with scope including the copyright information propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information will automatically propagate.

8. Moreover, Claims 99, 103, 104, 109, 110, 115, 119, 120, 125, 126, 131, 135, 136, 141, and 142 are rejected under 35 U.S.C. § 103 as being unpatentable over any of Dolphin, Fahn, Okano, Matsumoto, or Gasser (as applied in paragraph 7) and further in view of U.S. copyright law.

If any of the cited prior art is deemed deficient in teaching including copyright information along with the data, then Examiner notes that U.S. copyright law requires including copyright notification information along with copyrighted data to win actual infringement damages from unauthorized infringers. To avoid being limited to statutory damages, therefore, it would have been obvious to include copyright information with the protected data. Examiner has read "as a computer virus" as intended use with scope including the mark propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information as data will automatically propagate.

## REJECTIONS BASED ON DOUBLE PATENTING

9. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are directed to an invention not patentably distinct from claims 1-24 of commonly assigned U.S. Patent No. 5,646,999. Specifically, claims 1-24 in said Application anticipate the claims in this Application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, which is now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, in U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the optional limitations recited in the claims of this application. See, *supra* paragraph 7 for explanation of the scope of the claims in this application.
10. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

11. Claims 95, 97, 99, 101, 103-105, 107, 109-111, 113, 115, 117, 119-121, 123, 125-127, 129, 131, 133, 135-137, 139, 141, and 142 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims of said patent anticipate the claims in this application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, in U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the optional limitations recited in the claims of this application.
12. Claims 99, 103, 104, 109, 110, 115, 119, 120, 125, 126, 131, 135, 136, 141, and 142 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999 and further in view of U.S. copyright law.

If any of the cited prior art is deemed deficient in teaching including copyright information along with the data, then Examiner notes that U.S. copyright law requires including copyright notification information along with copyrighted data to win actual infringement damages from unauthorized infringers. To avoid being limited to statutory damages, therefore, it would have been obvious to include copyright information with the protected data. Examiner has read "as a computer virus" as intended use with scope including the mark propagating along with the data. Examiner notes that in data amenable to computer use, the copyright information as data will automatically propagate.

## **RESPONSE TO APPLICANT'S REMARKS TO THE LAST ACTION**

13. Applicants' arguments filed 9-16-1997 have been fully considered but they are not persuasive. Applicant argues (1) that the cited prior teaches editing, storing, copying, or transferring of digital data; (2) that the cited prior art does not teach using respective utilization keys; (3) that the cited prior art does not teach decrypting and encrypting again; (4) that the cited prior art does not teach using operations managed by copyright control program; and (5) that claims of U.S. Pat. No. 5,646,999 do not anticipate editing, storing,

copying, or transferring of digital data and performing said operations managed by copyright control program.

Regarding arguments (1) and (3), Examiner notes that the claims recite a method invention wherein the steps argued for are optional, thus comprising a scope wherein the steps are not performed.

Regarding argument (2), Examiner notes that the keys could be the same and therefore are anticipated by the prior art by virtue of the encryption/decryption performed in the cited prior art.

Regarding argument (4), the programs performing the encryption/decryption in the cited prior art anticipate the copyright control program recited in the claims of this Application.

Regarding argument (5), see supra response to arguments (1) and (4).

### **TIME PERIOD FOR RESPONSE**

14. A shortened statutory period for response to this action is set to expire **THREE MONTHS** from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). See 37 C.F.R. § 1.136 for extension of Time Period for Response.


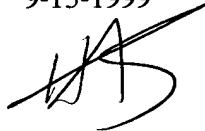
## INFORMATION ON HOW TO CONTACT THE USPTO

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Gail Hayes, can be reached on (703) 305-9711. The fax phone number for Technology Center 2700 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 305-3800 or 305-4700.

Hrayr A. Sayadian  
9-13-1999



GAIL O. HAYES  
SUPERVISORY PATENT EXAMINER  
GROUP 2700